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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,406	10/24/2005	Mauro Gelli	6626/PCT	4587
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TRUONG, THANH K				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/554,406

Applicant(s)

GELLI ET AL.

Examiner

THANH K. TRUONG

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-45, 51 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36 and 52 is/are allowed.
- 6) ☒ Claim(s) 26-35, 37-45 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment received on December 20, 2007.
2. Applicant's cancellation of claims 1-25 and 46-50 is acknowledged.
3. New claims 51 and 52 are added.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 26, 27 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by J. T. Yovanovich (2,785,700).

Yovanovich discloses an apparatus comprising: a mandrel (22), a winding member (26), at least two strips of web material (2, 4, 6, 8), at least one pressure member (47) disposed along the path of the tubular product being formed on the mandrel.

Yovanovich further discloses: a belt (24) (as in claim 27), and the pressure member is positioned downstream of the winding member (Figure 1) (as in claim 44).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 28-30 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over J. T. Yovanovich (2,785,700) in view of Tokutome Shinichi (11333219) or Miyake (6,659,152).

As discussed above in paragraph 5 of this office action, Yovanovich discloses the claimed invention, but it does not expressly disclose that the pressure member comprises an actuator to stress the at least one wheel and the mandrel against each other.

Tokutome Shinichi discloses an apparatus comprising: pressure members (17, 18) which comprise actuators (21, 22) to stress at least one wheel and the mandrel against each other (Figure 3).

Miyake discloses an apparatus comprising: pressure member (2) which comprises actuator (14) to stress at least on one wheel against the object between the wheel (2) to provide pressure upon the object that being moved between the wheels.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Yovanovich apparatus by incorporating the actuator as taught by Tokutome Shinichi or Miyake to provide means to apply force to pressure member against the object being moved between the pressure members (in this instance case, the object is the mandrel).

The modified Yovanovich by Tokutome Shinichi or Miyake further discloses:

the at least one wheel is positioned at a level of an edge line of adjacent turns of an outermost strip of web material forming the tubular product (Yovanovich – figure 1) (as in claim 29), and wherein the wheel (47) includes a circular edge disposed at an inclination, with respect to an axis of the mandrel, essentially equal to an inclination of a helical winding of the at least two strips of web material (Yovanovich – figure 1) (as in claim 30).

Regarding claim 51, the modified Yovanovich by Tokutome Shinichi or Miyake further discloses: the at least one pressure member comprises: at least one wheel; an actuator; at least one supporting element for the mandrel; and the at least one wheel and the supporting member are arranged around the mandrel such that the tubular product advances between the mandrel and the at least one wheel and the supporting element as recited.

8. Claims 31-33 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over J. T. Yovanovich (2,785,700) in view of Tokutome Shinichi (11333219) or Miyake (6,659,152) and further in view of L. F. Kreger (2,776,698).

As discussed above in paragraph 7 of this office action, the modified Yovanovich by Tokutome Shinichi or Miyake discloses the claimed invention, but it does not expressly disclose that the wheel comprise protuberances as recited in claim 31.

Kreger discloses an apparatus comprising: pressure member (61) wherein the circular edge of the wheel (61) has a series of protuberances to provide a better contact between the wheel and the mandrel.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Yovanovich apparatus by incorporating the pressure member as taught by Kreger to provide a better contact between the wheel and the mandrel.

The modified Yovanovich by Tokutome Shinichi or Miyake and Kreger further disclose:

the protuberances comprise teeth (figure 8) (as in claim 32);

the inclination of an axis of rotation of the wheel is adjustable with respect to the axis of the mandrel (Kreger – column 4, lines 27-33) (as in claim 33), and

wherein the at least one wheel (61) is motorized (Figure 8) (as in claim 43).

9. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over J. T. Yovanovich (2,785,700) in view of L. F. Kreger (2,776,698).

As discussed above in paragraph 5 of this office action, Yovanovich discloses the claimed invention, but it does not expressly disclose that the pressure member comprises at least one supporting element for the mandrel as recited in claim 37.

Kreger discloses an apparatus comprising: the pressure member (61) comprises at least one supporting element (61) for the mandrel (12).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Yovanovich apparatus by incorporating the pressure member that has at least one supporting element as taught

by Kreger to provide a means to support the mandrel under the pressure of the wheel (61) above it.

The modified Yovanovich by Kreger further discloses: the at least one pressure member comprises two angularly staggered supporting elements arranged to provide the mandrel with a reaction force to stress applied by the at least one wheel (Kreger - figure 8) (as in claim 38); and the contact between mandrel, the at least one wheel, and the supporting element lie approximately on a plane orthogonal to an axis of the mandrel (Kreger - figure 8) (as in claim 39).

10. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over J. T. Yovanovich (2,785,700) in view of Tokutome Shinichi (11333219) or Miyake (6,659,152) and further in view of Isotani Keiichi (JP 59 009044).

As discussed above in paragraph 7 of this office action, the modified Yovanovich by Tokutome Shinichi or Miyake discloses the claimed invention, but it does not expressly disclose that the at least one wheel is carried by a support arranged to slide in a sleeve and torsionally constrained to the sleeve as recited in claim 34.

Isotani Keiichi discloses an apparatus comprising: the at least one wheel (7) is carried by a support arranged to slide in a sleeve (5) and torsionally constrained to the sleeve (Isotani Keiichi - figure 5).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Yovanovich apparatus by

incorporating the support arrangement as taught by Isotani Keiichi to provide an effective means to support the pressure member.

The modified Yovanovich by Tokutome Shinichi or Miyake and Isotani Keiichi further discloses: wherein the sleeve (5) is arranged to be locked in an angularly adjustable position with respect to a fixed load-bearing structure (Isotani Keiichi – figures 1-5).

11. Claims 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over J. T. Yovanovich (2,785,700) in view of W. Wade (2,250,430).

As discussed above in paragraph 5 of this office action, Yovanovich discloses the claimed invention, but it does not expressly disclose that the pressure member comprises two wheels acting on the tubular product being formed around the mandrel.

Wade discloses an apparatus comprising the pressure member comprises two wheels (21) acting on the tubular product being formed around the mandrel (10).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Yovanovich apparatus by incorporating the two pressure member as taught by Wade to provide an effective pressure means to form the tubular product on the mandrel.

The modified Yovanovich by Wade further discloses: the two wheels (21) are arranged to act on an outer surface of the tubular product (22), a first wheel of the two wheels at a level of a joining line of adjacent turns formed by an outermost strip of web material and a second wheel of the two wheels at a level of a joining line of adjacent

turns formed by an innermost strip of web material (as in claim 41), and the two wheels are disposed staggered by about 180 degrees around an axis of the mandrel and in a position wherein a straight line uniting contact points of the two wheels with the tubular product being formed on the mandrel is approximately orthogonal to the axis of the mandrel (Wade – figure 1) (as in claim 42).

12. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over J. T. Yovanovich (2,785,700) in view of Drummond et al. (5,251,809).

As discussed above in paragraph 5 of this office action, Yovanovich discloses the claimed invention, but it does not expressly disclose that the pressure member is positioned upstream of the winding member as recited in claim 45.

Drummond et al. discloses an apparatus wherein the pressure member (108) is positioned upstream of the winding member (124).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Yovanovich apparatus by incorporating the arrangement of the pressure member as taught by Drummond et al. to provide an alternative arrangement of the pressure member.

In response to Applicant's argument that REF A includes additional structure not required by Applicant's invention, it must be noted that REF A discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

Allowable Subject Matter

13. Claims 36 and 52 are allowed.

Response to Arguments

14. Applicant's arguments filed December 20, 2008 have been fully considered but they are not persuasive.

15. In response to the Applicant's argument that:

"The pressure exerted against the mandrel by the pressure member enhances the effect of the adhesive applied to a surface of the at least two strips of web material. The purpose of the pressure and the pressure applied are therefore quite different as between that taught in Yovanovich and provided by the machine as claimed by applicants", and

"Accordingly, Yovanovich does not teach a machine as claimed wherein the pressure member promotes adhesion of at least two strips including adhesive to form a tubular product.",

this is not found persuasive for the following reason: The pressure member (47) in Yovanovich applied pressure against the mandrel (22) and to the at least two strips of web material (2, 4, 6, 8) present on the mandrel **as recited in claim 26**. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

16. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 601 (CCPA 1915). However, there is no requirement that a motivation to make

the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 110 USPQ 209 (CCVA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA. 1969).

In this case, as discussed above, Yovanovich discloses the claimed invention, but it does not expressly disclose the various embodiments of the invention, for example:

Claims 28-30 and 51, Yovanovich modified by Tokutome Shinichi or Miyake provides means (an actuator) to apply force to pressure member against the object being moved between the pressure members.

Claims 31-33 and 43, Yovanovich modified by Kreger provides a better contact between the wheel and the mandrel.

Claims 37-39, Yovanovich modified by Kreger provides a means to support the mandrel under the pressure of the wheel (61) above it.

Claims 34 and 35, Yovanovich modified by Isotani Keiichi provides an effective means to support the pressure member.

Claims 40-42, Yovanovich modified by Wade provides an effective pressure means to form the tubular product on the mandrel.

Claim 45, Yovanovich modified by Drummond et al. provides an alternative arrangement of the pressure member.

Furthermore, it would have been obvious to combine the references, since it has been held that applying a known technique to a known device would have yield predictable results to one of ordinary skill in the art at the time of the invention (*KSR*).

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **THANH K. TRUONG** whose telephone number is (571)272-4472. The examiner can normally be reached on Mon-Fri 9:00AM - 5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tkk
April 2, 2008.

/Thanh K Truong/
Primary Examiner, Art Unit 3721.